

Amendment Under 37 C.F.R. § 1.111
Serial No. 09/732,788
Sughrue Ref: Q62242

REMARKS

Claim Rejections Under 35 U.S.C. § 103

Claims 3 and 5 are rejected over previously cited Birchler (US 4,043,027) in view of newly cited Seiki (US 5,759,052). Claims 3 and 5 are rejected over previously cited Saito (5,620,711) in view of newly cited Stevens et al. (US 5,620,338) (or Stevens in view of Saito).

Claim 3

With respect to independent claim 3, Applicant respectfully traverses this rejection.

As an initial matter, the Examiner has not considered the recited features of the terminal when determining the patentability of the invention. Therefore, Applicant respectfully submits that it is not a mold that is being claimed, but instead the combination of an upper mold, a lower mold, and a terminal fitting that make up a system for waterproofing a terminal. Although Applicant believes that claim 3, as presented in the December 8, 2003 Amendment, already clearly conveyed this system, Applicant has amended the claims to recite a “system” for providing a waterproof a terminal connecting portion.

Applicant notes that it is impermissible for the Examiner to overlook a structure of the claimed system. In fact, even if one were to *assume arguendo* that the Examiner’s disregard of positively recited features would be appropriate for a claim directed to a mold alone, the Examiner’s comments are clearly inappropriate with respect to claim 3, which is directed to an entire system.

In addition, Applicant respectfully requests the Examiner to withdraw the rejection of claim 3 because neither the combination of Birchler and Seiki nor the combination of Saito and

Stevens teaches or suggest the claimed system. For example, there is no suggestion to modify the mold structures of Birchler or Saito so that they would include a terminal fitting and an upper mold having a dome-shaped ceiling face with a curvature that is coincident with the curvature of the upper face of the terminal fitting.

For example, Birchler and Saito merely disclose mold structures for molding around conductor wires 10 (Birchler) and wires 21 (Saito). There is no motivation of record that if a terminal fitting was instead used instead of a wire, the shaped ceiling face of the upper mold would have a curvature that is coincident with the curvature of the upper face of the terminal fitting. The Examiner's asserted motivation for the modification are encapsulating the terminal (Birchler) and waterproofing a terminal fitting (Saito). However, these alleged motivations appear to be based on hindsight since there is no evidence of record pertaining to any advantage in encapsulation or waterproofing with an upper mold having a curvature that is coincident with the curvature of the upper face of the terminal fitting¹.

Regarding Stephens, the Examiner provides the discussion about the relationship between the shape of molded terminal 50 and the shape of the molding cavity. Applicant would like to

¹ The USPTO is held to a *rigorous* standard when trying to show that an invention would have been obvious in view of the combination of two or more references. *See, In re Sang Su Lee*, 61 USPQ2d 1430 (Fed. Cir. 2002), *citing, e.g., In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references."). In *Lee*, the Federal Circuit further emphasized that the "need for specificity pervades this authority." (*Lee* at 1433 (*citing In re Kotzab*, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for ... (footnote continued)

again point out that claim 3 recites the relationship between the shape of the bare terminal fitting to be molded (corresponding to the conductor 38 in Stephens) and the shape of the molding cavity. The Examiner should note that Stephens teaches the shape of the molded terminal 50 is regardless of the number and size of conductors 38 (*See*, Col. 3, lines 34-39).

Finally, Seki shows, as a final product, a terminal fitting in which any portion is not covered with resin. Therefore, there is no motivation to combine Birchler and Seki because Seki does not require the resin molding process.

Therefore, Applicant respectfully requests the Examiner to withdraw the rejection of independent claim 3.

Claim 5

In addition, Applicant respectfully requests the Examiner to withdraw the rejection of dependent claim 5 at least because of its dependency from claim 3 and because neither the combination of Birchler and Seiki nor the combination of Saito and Stevens teaches or suggest the claimed system in which the dome-shaped ceiling face comprises at least two radii of curvature in an identical cross-sectional plane, in accordance with a shape of an outer face of the terminal fitting.

For example, the upper mold 62 of Birchler does not have two radii of curvature, but merely has a single radius of curvature. Birchler at, for example, Fig 6 (encapsulated material 92). In addition, although the molds 3a and 3b of Saito have multiple radii (Saito at Fig. 1) the

combination in the manner claimed”)). The factual inquiry into whether to combine references “must be based on objective evidence of record.” *Lee* at 1433.

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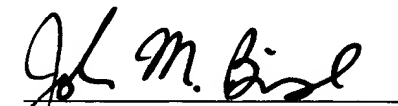
multiple radii are not "in accordance with a shape of an outer face of" the wire 21. In fact, it appears that the shape of the radii of the mold are just the opposite, purposefully made so that they do not match the shape of the wire 21. Saito at Fig. 5.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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